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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,093	05/24/2001	Eddy Daelmans	501139	2724

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LEYDIG VOIT & MAYER, LTD  
6815 WEAVER ROAD  
ROCKFORD, IL 61114-8018

[REDACTED] EXAMINER

DICUS, TAMRA

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1774

DATE MAILED: 09/11/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/807,093	DAELMANS ET AL. <i>(P)</i>
	Examiner Tamra L. Dicus	Art Unit 1774

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 May 2001 (preliminary amendment).
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 5-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5-13 are objected to because of the following informalities: Applicant has excluded the term “or” from claim 7. Please insert as to insure proper multiple dependency.
2. Claims 7 and 13 are objected to under 37 CFR 1.75(c) as being in improper form because they depend on claims which are also multiple dependent See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 5-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not enable one skilled in the art to make the invention. The “right side or printed side”, “opposite side to the side of the strip”, “initial film”, are not defined, identified, or referenced. Furthermore, it is not clear how structures of strips 24 and 26 are different from strip 28.
5. While Applicant is entitled to be his or her own lexicographer, the term “the right side” has a meaning that conflicts with the term’s art-accepted meaning. See pg. 7.
6. Figure 9 is not referenced in the specification.
7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 5 and 10, while applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term “right side” in claims 5 and 10 are used by the claim to mean “the face which is going to be on the outside of the article”. While, the art-accepted term “right side” refers to lateral direction. Hence, referring to claim 10, it is confusing how bands or strips can be “on the right side and the other on the reverse side of the film” when the “right side” is defined by the specification as being “the face which is going to be on the outside of the article”, which is by definition the reverse side. This does not make sense.

10. Additionally, in claim 10, Applicant refers to “one of the bands”. However, no bands have been referenced; therefore, the phrase is indefinite.

11. Regarding Claim 10, it is unclear what “mutual superposition”, “mutual adhesion”, “controlled adhesion”, or “paying-out” means. Further, it is confusing as to if there is one strip or two, see line 5 vs. line 7. The phrase “on the reverse side” does not make reference to what side it is on at line 12.

12. Regarding claim 10, the first reference to the inclusion of a “strip of cold-sealing coating” implies a singular strip, however, subsequent reference of this term conveys plurality, (“said strips”) which implies more than one strip.

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13. Regarding claim 5, the term “the dry type” renders the claim(s) indefinite because the claims include elements not actually disclosed (those encompassed by “type”), thereby rendering the scope of the claims unascertainable. See *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955).

14. Regarding claim 5, it is not clear how a coating can be “designed to be...”.

15. The term “particularly” used in claim 10 is indefinite.

16. In claim 10, the phrase “packaging for wrapping for packaging” is confusing and makes no sense.

17. Claim 10 recites the limitation “the bands” in line 6 and “the right side”. These limitations do not refer to anything specific.

18. In claim 10, the phrase “intended to be closed” is indefinite as it lends no positive recitation to the claim. It is not definite as to whether the sheets are closed.

19. In claim 10, the phrase “but not strong enough” is indefinite as “strong” is a relative term.

20. The phrase “when there is mutual contact” adds no positive recitation to the claim and is therefore indefinite.

21. It cannot be understood as to what the “reverse side” is referring to. The Examiner is uncertain as to whether Applicant is referring to the flip side of the film or another undisclosed side.

22. In claim 11, the term “most” is relative and therefore indefinite.

23. Claim 12 is indefinite because it cannot be ascertained what “the sealing coating of the strips of sealing coating” is referring to. According to claim 10, from which claim 12 depends upon, there are only strips.

***Claim Rejections - 35 USC § 102***

24. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in–

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

25. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

26. Claims 10 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 3,055,576 to Ottinger et al.

Ottinger teaches a wrapping material that is wound, comprising a web, where a water proof stripe (strip) of self-sealing latex adhesive on two outer edges of the web, which does not adhere to a surface when pressed against another surface such as in the wound roll. See col. 1, lines 20-31, col. 2, lines 1-35, col. 3, lines 5-28, and Figures 1-5. Ottinger explains at col. 3, line 26 that such a wrapping may be suitable for other materials besides carpet to wrap elongated objects.

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27. Claims 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,287,658 to Cosentino et al.

Cosentino teaches a flexible packaging composite film in a wound roll. The flexible packaging composite film is comprised of polypropylene blends or coextruded films, a cold seal adhesive of latex, a release layer, a polyester support for the releases layer (non-stick coating), with the option of containing lacquers. See col. 2, lines 6-36, col. 4, lines 1-43, col. 5, lines 10-45, and Example.

Regarding claims 5-13, the following phrases are process limitations:

- “...once the sheet has been folded” in claim 5
- “...is deposited at least partially” in claim 6
- “...is spread out in the form of an egg-shaped strip” in claim 7
- “...is applied before the sealing coating” in claim 8
- “is coextruded in the substrate of the sheet” in claim 9
- “...can be cut transversely into separate sheets ...” in claim 10
- “being obtained from a film” in claim 10
- “by folding around the article...” in claim 10
- “...hold the packaging finally closed upon the last folding sequence..” in claim 10
- “...once the sheet has been folded around the article...” in claim 11
- “...arranged at least partially...” in claim 11
- “...holding the folds in place around the said article” in claim 11
- “...is spread out in the form of an oval strip” in claim 12
- “...is applied before the sealing coating...” in claim 13

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

28. Claims 5-13 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 5,934,809 to Marbler.

Marbler teaches a flexible packaging film on a roll that forms a “pouch”. The film is comprised of polypropylene, paper, or metallic layers, used with lacquers, printing inks, colorants, sealing layers (cold/hot/adhesive), wax (non-stick coating), and/or extrusion layers. The sealant is on the edges/seams. Marbler also teaches the film may be applied over the print coating on a packaging material at col. 3, line 60. See col. 2, line 5-40, col. 3, lines 30-60, col. 4, lines 1-40, col. 5, lines 5-45, and Figure 1, 2, and 6.

Regarding claims 5-13, the following phrases are process limitations:

- “...once the sheet has been folded” in claim 5
- “...is deposited at least partially” in claim 6
- “...is spread out in the form of an egg-shaped strip” in claim 7
- “...is applied before the sealing coating” in claim 8
- “is coextruded in the substrate of the sheet” in claim 9
- “...can be cut transversely into separate sheets ...” in claim 10

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- “by folding around the article...” in claim 10
- “...hold the packaging finally closed upon the last folding sequence..” in claim 10
- “...once the sheet has been folded around the article...” in claim 11
- “...holding the folds in place around the said article” in claim 11
- “...is spread out in the form of an oval strip” in claim 12
- “...is applied before the sealing coating...” in claim 13

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

The limitations of claims 10-13 have been met under 35 U.S.C. 102 (b) and (e).

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,993,962 to Timm et al. Timm teaches a resealable packaging material comprising strips of cold seal adhesive with the use of specialty inks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

September 5, 2002

